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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,243	10/20/2003	Liuxin Newman	5447-8	3864

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EXAMINER

WELCH, GARY L

ART UNIT PAPER NUMBER

3765

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/689,243	<b>Applicant(s)</b> NEWMAN, LIUXIN	
	<b>Examiner</b> Gary L. Welch	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed 23 February 2006 has been reviewed and considered. Applicant stated that he had a telephone conversation with the examiner regarding the rejections in the Final Office Action mailed on 20 December 2005. Applicant further states that the examiner agreed with the applicant in that the prior art to Lambert and Lee do not disclose a thimble extending above a first knuckle position and about its full circumference. However, the examiner takes issue with this position. The examiner agreed with the applicant that the prior art to Lee (U.S. 3,531,029) does not disclose a thimble extending above a first knuckle position and about its full circumference. The examiner agreed with the applicant that Lambert (U.S. 5,609,165) does not disclose a substantially rigid thimble. The thimble of Lambert provides complete protection to the user's finger (Col. 1, lines 35-49) and there extends up over the first knuckle position and about its full circumference.

The prior art rejection of claims 1, 3, 5 and 6 being anticipated by Lee (U.S. 3,531,029) are withdrawn.

However, after further review, the prior art rejection of claims 1, 2, 4 and 7-12 as being anticipated by Lambert remain. The sole issue regarding Lambert is whether or not the thimble of Lambert is substantially rigid. The examiner believes the prior art to Lambert is a substantially rigid thimble because it is fabricated from stainless steel. Applicant's instant invention is also fabricated from stainless steel (see specification page 7, lines 5-6). There is no mention in applicant's specification regarding the

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thickness of the material, etc. Additionally, the terminology used by the applicant "substantially rigid" does not mean that the finger is completely straight. The specification allows for the finger to be bent not more than 25 degrees (refer to claims 10 and 11).

The examiner is treating this as a new Final Rejection since the examiner agreed with the applicant during the telephone conversation that Lambert was not substantially rigid. Additionally, an updated search and further review of the prior art of record has prompted additional rejections based upon new art.

### ***Claim Objections***

2. Claims 6 and 11 are objected to because of the following informalities: The claims require limitations (i.e., between 25 and 45 mm in length and not bent more than 15 degrees) that are not supported by the specification. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

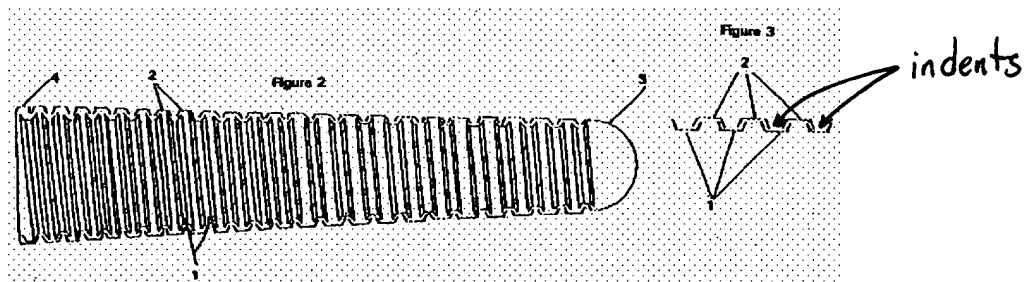
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4 and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lambert (U.S. 5,609,165).

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Lambert discloses a substantially rigid thimble (figure 1). The thimble is fabricated from two elongate strips (1, 2) which may be metal (i.e., stainless steel) or heat treated plastic and is therefore substantially rigid. The thimble extends up and over the first knuckle position of a wearer since the specification states that some rings (20, 30) may be extended in length as in between the knuckle joints (Col. 3, lines 23-25). The outer surface of the thimble is a needle-contacting surface having one or more indents between the tip of the finger and a position adjacent or past the first knuckle position (see figures below).



With regard to claim 2, the invention is disclosed above.

With regard to claim 4, a multiplicity of indents in the needle-contacting surface is provided between a position adjacent the tip of the finger and a position adjacent the first knuckle.

With regard to claims 7 and 8, the inside of the front face of the thimble is substantially flattened (Col. 2, lines 45-51).

With regard to claim 9, the thimble tapers inwardly along its length as it extends towards the fingertip.

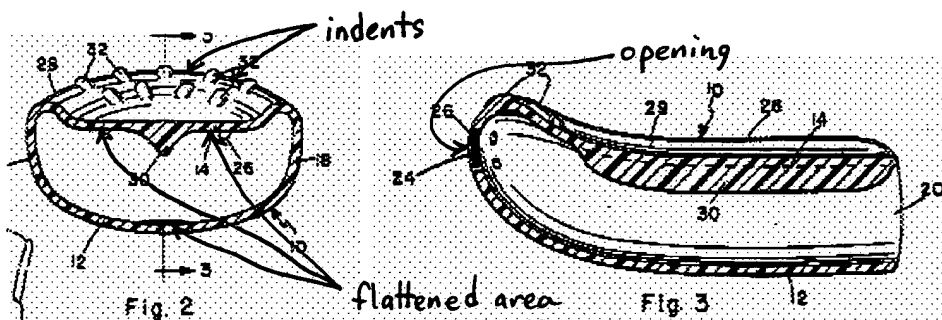
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With regard to claims 10-12, there are no positively recited methods steps.

Additionally, the structure of Lambert would inherently perform the claimed matter since the structure of the instant invention is disclosed by Lambert.

5. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ames et al. (U.S. 3,228,033).

Ames et al. discloses a substantially rigid device 10 adapted to extend up over the first knuckle position about its full circumference. The device 10 is molded from a synthetic plastic (i.e., a high density polyethylene HDPE) having a desired hardness and rigidity (Col. 2, lines 7-13). Since the device is substantially rigid then the user's fingers are maintained substantially straight. The device 10 has a contacting surface where one or more indents (Figure 2) are provided between the tip of the finger and a position adjacent the first knuckle.



With regard to claim 2, the invention is disclosed in the above rejection.

With regard to claim 3, the device 10 is open at both ends 26 so that the tip of the finger is not covered.

With regard to claim 4, a multiplicity of indents (see figure above) is provided in the needle contacting surface and extend between a positions adjacent the tip of the finger and a position adjacent the first knuckle.

With regard to claims 5 and 6, the device 10 is open ended. Additionally, the size of the device falls within the claimed parameters since it extends past the first knuckle (20 or 25 mm would represent the position adjacent the first knuckle).

With regard to claim 7, the inside of the front face of the device 10 is substantially flattened (see figure above).

With regard to claim 8, one or more inside faces of the device are substantially flattened (see figure above).

With regard to claims 10-12, the invention is disclosed in the above rejections.

The method steps do not recite any structure that further limits the structural claim (i.e., claim 1) from which it depends. Furthermore, the device is fabricated from similar material (i.e., rigid material) as the instant invention and therefore it is assumed that similar characteristics with regard to bending of the finger would occur with the device 10 and the instant invention.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham (U.S. 6,237,148) in view of Pugh (U.S. 3,728,736).

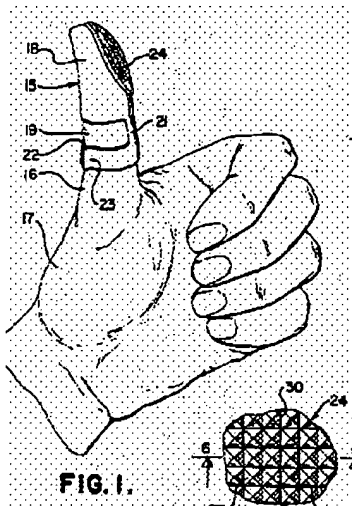
Graham discloses a substantially rigid device 10 for preparing foods with sharp kitchen utensils (Col. 3, lines 65-66) and is adapted to extend up over the first knuckle position about its full circumference (Figures 1-4). Since the device 10 is fabricated from a rigid material, then the user's finger will be maintained substantially straight.

However, Graham does not disclose a contacting surface with one or more indents between the tip of the finger and a position adjacent or past the first knuckle position.

Pugh teaches a thumb or finger guard 15 for assisting a user in preparing foods with sharp kitchen utensils. A contacting surface 24 is provided between the tip of the finger and a position adjacent to the first knuckle position. Surface 24 enables the user to securely grip the food when cutting, chopping or pairing the food (Col. 2, lines 33-56) thereby preventing injury to the user's hand/finger especially when the food becomes smaller in size (Col. 4, lines 7-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a contacting surface 24 between the tip of the finger and a position adjacent to the first knuckle position as taught by Pugh to the device of Graham so as to enable the user in securely gripping food when cutting, chopping or pairing the food (Col. 2, lines 33-56) thereby preventing injury to the user's hand/finger especially when the food becomes smaller in size (Col. 4, lines 7-11).





With regard to claim 2, the invention is disclosed in the above rejection.

With regard to claim 4, a multiplicity of indents (see figure above) is provided in the needle contacting surface and extend between a positions adjacent the tip of the finger and a position adjacent the first knuckle.

With regard to claims 10-12, the invention is disclosed in the above rejections.

The method steps do not recite any structure that further limits the structural claim (i.e., claim 1) from which it depends. Furthermore, the device is fabricated from a rigid and therefore it is assumed that similar characteristics with regard to bending of the finger would occur with the device and the instant invention.

### **Conclusion**

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Davis '962, Sanders '414, Dante '056, Paige '356 and Armat at '733 disclose various finger coverings.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L. Welch whose telephone number is (571) 272-4996. The examiner can normally be reached on Mon-Fri 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gary L. Welch  
Primary Examiner  
Art Unit 3765

glw